

## **REMARKS**

### **I. Status of the Claims**

Claims 18-20, 57, 58 and 60-67 were pending in this application. Claims 18-20, 57, 58 and 60-63 have been rejected, claim 61 has been canceled and claims 64-67 have been withdrawn. With this paper, Applicant has amended claim 18. Therefore, claims 18-20, 57, 58, 60, and 62-63 are pending. Reconsideration of the application based on the arguments submitted below is respectfully requested.

### **II. Claim Rejections under 35 U.S.C. § 102**

Claims 18, 57, 60 61 and 63 stand rejected under 35. U.S.C. §102(b) as being anticipated by Zhao et al. (U.S. Patent No. 6,423,764. Applicant respectfully traverses the rejection.

Applicant would first like to point out the amendment to claim 18 which includes the action of removing the container or preform from the liquid medium. This addresses the last point of the Office action regarding the “Examiner’s position that Zhao meets any structural limitations imparted by this process limitation since the colorant contacts permanently. With this amendment, Zhao cannot be used as a reference under 35 U.S.C. 102(b) as “[a] claim is **anticipated** only if each and every element as set forth in the claim is found, either expressly or inherently

described, in a single prior art reference.” MPEP §2131 citing Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In further illustrating how Zhao cannot be used as a reference under 35 U.S.C. §102(b), Applicant has provided a declaration by Mark Frost, a person of skill in the art employed by the Assignee of the above-captioned application.

As indicated in the Declaration Zhao incorporates a coloring agent as indicated within Column 2, Line 65 to Column 3, line 12. Each of the steps in which the coloring agent could be added is prior to the molding process and the color will be homogenously distributed throughout the polymer during the molding process. The only illustrations provided by Zhao include melt processes wherein the density of the colorant will be the same throughout the entire polymer, as the colorant does not migrate, which is further explained in the declaration. As a result, an article produced from the polyester plastics containing the colouring material of Zhao, will include colouring material throughout the bulk of the article – that is, the density of colour will be consistent, throughout the bulk of the product; and the colour of inside and outside surfaces of the product will be identical. The entirety of the article will be of the same colour.

In contrast, in accordance with the present invention as expressed in claim 18, an existing container or container preform is post-treated with one or more disperse dyes in a liquid medium to cause binding of dye to the container or container preform. The process will not produce uniform colour throughout the bulk of the polyester from which the container or container preform is made as disperse dyes only gradually migrate into materials such as polyethylene terephthalate.

Through the combination of the declaration and the amendment to claim 18, Applicant has provided “evidence of criticality regarding the presently claimed process” and further differentiated Zhao as the amendment requires removing the preform or container from the liquid medium containing the disperse dye. As stated in MPEP 2113 “[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

Withdrawal of the Section 102 rejection is thus solicited.

### III. Claim Rejections under 35 U.S.C. § 103

Claims 18-20, 57, 58 and 60-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Luka et al. (U.S. Patent No. 6,393,803) in view of Zhao et al. (U.S. Patent No. 6,423,764). Applicant respectfully disagrees with this rejection and requests that this rejection be withdrawn.

Applicant would like to point out the recent Federal Register Note (Volume 75, No. 69, September 1, 2010) which states

**“[p]redictability as discussed in *KSR* encompasses the expectation that prior art elements are capable of being combined, as well as the expectation that the combination would have worked for its intended propose. An inference that a claimed combination would not have been obvious is especially strong where the prior art’s teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements.**

Applicant again would like to point to the declaration of Mark Frost which specifically describes Applicant’s invention and provides an analysis of the two references cited in the Office Action. Respectfully, while the two references may both include discussion about different dyes, they are incapable of being combined as neither would then work for its intended purpose. As stated in the declaration, it is inevitable that the colorant as taught by Zhao would be distributed throughout

the polymeric material by virtue of the process to which the colorant is subjected – i.e. melt processes such as injection moulding. Thus the density of the colorant will be the same throughout the polymer and the density of colorant at all surfaces would be the same.

Conversely, Luka teaches one skilled in the art of coatings which are cured and bonded to a preform with the only specific example provided as a “barrier material such as an epoxy-amine.” As provided in the declaration, such chemical compositions react under heat to form a durable, three-dimensional network on the surface of the preform. Thus, Luka provides a separate layer on the surface of the preform while Zhao provides a homogenous coloring throughout the polymer material. The processes and purposes of Luka and Zhao are completely different regarding process and the final structure. Luka cannot be used to provide a homogenous coloring as is provided by Zhao and Zhao cannot provide a separate layer of a colored coating on top of the surface of the container as does Luka. At best, a combination of the two processes would provided a preform or container having a homogenous coloring as provided by Zhao with a surface layer of coloring on top of the preform or container as provided by Luka.

Neither reference provides the advantages of Applicant’s invention. As the disperse dyes of Applicant’s invention are not chemically reacted, they can be readily removed in recycling processes. Luka produces a coating which is cured

with new covalent bonds, while quite durable, it is not intended to be readily removed in subsequent processing such as recycling.

Otherwise stated, the references combined or separate cannot be utilized to provide the invention of the above-captioned application as provided in the amended claims. Neither reference can provide the migration of dye within only the surface of a preform or container but rather would lead one skill in the art to utilize a coating over the surface of the preform or homogeneous coloring throughout the preform.

Applicant reincorporates the arguments previously advanced in the response of December 23, 2009 and has further has provided the accompanying declaration. With respect to Section 8 of the Office Action, Applicant has provided evidence to the contrary regarding each point through the declaration.

Furthermore, the amendments to claim 18 further delineate Applicant's invention as the time period and removal from the liquid medium having the disperse dyes only provides for penetration of the dye into the surface of the preform or container. This is further supported by the declaration.

For the above reasons, withdrawal of the Section 103 rejection is thus solicited.

### Conclusion

Accordingly, Applicant believes that all of the pending claims are in condition for allowance and respectfully requests a favorable action to that effect.

Applicant has commented on some of the distinctions between the cited references and the claims to facilitate a better understanding of the present invention. This discussion is not exhaustive of the facets of the invention, and Applicant hereby reserves the right to present additional distinctions as appropriate. Furthermore, while these remarks may employ shortened, more specific, or variant descriptions of some of the claim language, Applicant respectfully notes that these remarks are not to be used to create implied limitations in the claims and only the actual wording of the claims should be considered against these references.

The Commissioner is authorized to charge any deficiency or credit any overpayment associated with the filing of this Amendment and Response to Deposit Account 23-0035.

Respectfully submitted,

/Ryan D. Levy, 58,518/  
Ryan D. Levy - Reg. No. 58,518

Wadley & Patterson, P.C.  
Customer No. 23456  
1600 Division Street, Suite 500  
Roundabout Plaza  
Nashville, TN 37203  
(615) 242-2400